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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,397	04/20/2000	Richard R. Reisman	RRR-00-001US	4230
7590 11/05/2004 Robert A. Westerlund 1820 N. Herndon Street Arlington, VA 22201			EXAMINER NGUYEN, TANH Q	
			ART UNIT 2182	PAPER NUMBER
DATE MAILED: 11/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/553,397

**Applicant(s)**

REISMAN, RICHARD R.

**Examiner**

Tanh Q. Nguyen

**Art Unit**

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08/25/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/25/04 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 16-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant cited col. 25, lines 42-65 to provide support for the amendment to independent claims 16 and 28. The citation however does not support "capturing and storing the at least one desired data object from the received broadcast data stream in accordance with the fetched schedule and based upon the at least one desired data

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object's object identifier" when they are examined in conjunction with claims 17-19 and 29-31. Specifically, it appears that the at least one desired data object from the received broadcast data stream was captured and stored in a temporary storage location - based upon the at least one desired data object's object identifier (col. 25, lines 59-62); the at least one desired data object is **then** fetched by a schedule transport function from the temporary storage (col. 25, lines 62-65), hence the capturing and storing of the at least one desired data object from the received broadcast data stream not being in accordance with the fetched schedule. Rather, the fetching function is in accordance with a fetched schedule (see claims 17-19 and 29-31).

Applicant is required to cancel the new matter in the reply to this Office Action.

Furthermore, the citation does not provide support for "fetching a schedule from a remote schedule source".

4. Claims 16-38 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for capturing and storing the at least one desired data object from the received broadcast data stream based upon the at least one desired data object's object identifier, does not reasonably provide enablement for "capturing and storing the at least one desired data object from the received broadcast data stream **in accordance with the fetched schedule and based upon the at least one desired data object's object identifier**". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims (see paragraph 2).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 16-24, 26; 28-35, 37 are rejected under 35 U.S.C. 102(b) as being anticipated by **Young (USP 4,706,121)**.

7. As per claim 16, **Young** teaches a method (col. 7, line 33-col. 8, line 22) for operating a user station [90, FIG. 3], comprising:

a remote source [20, FIG. 1] supplying schedule information (col. 6, lines 20-22) and information identifying programs selected from the schedule information on the basis of the user selection (col. 7, lines 62-64), hence fetching a schedule from a remote schedule source;

receiving a broadcast data stream [135, FIG. 3; col. 7, lines 66-68; col. 8, lines 15-19], the broadcast data stream including at least one desired data object (a selected program) and at least one other data object (a non-selected program), wherein the at least one desired data object is identified in the broadcast data stream by an object identifier (e.g. the selected program is identified in the broadcast data stream by the program title that is selected by the user: col. 7, lines 62-64); and

turning on a VCR [150, FIG. 3] in accordance with the fetched schedule (col. 8, lines 12-13) and based upon the user selection of the program identified by the program

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title (col. 7, lines 62-64) for unattended recording of the selected program (Abstract, lines 15-17), hence capturing and storing the at least one desired data object from the received broadcast data stream in accordance with the fetched schedule and based upon the at least one desired data object's object identifier (program title selected by the user).

8. As per claims 17-24, 26, Young teaches:

recording the selected program on a VCR (Abstract, lines 15-17), hence the at least one desired data object being stored in temporary storage at the user station (video tape for storing the selected program) – claim 17;

the selected program being recorded on a VCR (Abstract, lines 15-17), hence fetching the at least one desired data objects from the temporary storage when the videotape is played back on the VCR – claim 18;

a TV receiver [126, FIG. 3] at the user station, the TV receiver being capable of receiving the selected program from the VCR and displaying the selected program on the TV monitor, hence preparing the fetched at least one desired data object for use at the user station – claim 19;

selecting a data source from a listing of a plurality of independently operated data sources (HBO, ESPN...) for supplying the selected program (col. 4, lines 14-24; col. 10, line 11-col. 12, line 42), hence the at least one desired data object being supplied by a first one of a plurality of independently operated data sources and selecting the first one

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of the plurality of independently operated data sources from a listing of each of the plurality of independently operated data sources – claim 20;

an application programming interface [220, FIG. 5; 116, 118, FIG. 3] providing inputs to a CPU [110, FIG. 3] for supplying user selection (col. 7, lines 51-54; col. 9, line 46-col. 10, line 10), hence an application programming interface enabling a software application to select the first one of the plurality of independently operated data sources – claim 21;

the broadcast data stream being broadcasted by a data source from a plurality of independently operated data sources including HBO, ESPN... (col. 4, lines 14-24) to the subscribers of such data sources, hence the data stream being multicast – claim 22;

tuning the user station to receive the broadcast data stream (col. 4, lines 48-52; Abstract, lines 10-17) – claim 23;

the broadcast data stream being broadcasted by a data source from a plurality of independently operated data sources including HBO, ESPN... (col. 4, lines 14-24) to the subscribers of such data sources, hence the at least one desired data object comprising data to which a user at the user station is entitled – claim 24;

the user at the user station selecting the at least one desired data object to be captured and stored (col. 7, lines 51-54) – claim 26;

9. As per claims 28-35, 37, Young teaches a method for operating a user station to capture and store at least one desired data object from a received data stream in accordance with a fetched schedule in claims 16-24 and 26, hence teaches a user

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station for such a method. Young further teaches the logic for receiving the broadcast data stream identifying the desired data object (col. 12, lines 13-24).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 25, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Young** in view of **Logan et al. (USP 5,371,551)**.

Young teaches the claimed invention except for the method being performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have been previously been captured and stored during a prior time the method is performed; or except for the user station enabling a user to access the captured and stored desired data object while the user station receives, captures and stores additional desired data objects.

In essence, Young's VCR does not allow for receiving, capturing and recording additional desired data objects while enabling the user to play back desired data objects that have been previously been captured and stored. Young, however, teaches recording of selected programs with a recording device that is other than a VCR (col. 3, lines 53-56).



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**Logan et al.** (Logan) teaches a recording device [5, FIG. 1] that allows for additional desired data objects to be received, captured and stored while enabling the user to play back desired data objects that have been previously been captured and stored (Abstract, lines 1-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Logan's recording device into Young's method since Young teaches the use of a recording device that is other than a VCR and since the incorporation of Logan's device would allow Young's method to be performed a plurality of consecutive times, wherein during each time the method is performed, a user at the user station can access desired data objects that have been previously been captured and stored during a prior time the method is performed. The combination would, likewise, allow the user station to enable the user to access the captured and stored desired data objects while the user station receives, captures and stores additional desired data objects.

12. Claims 27, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Young** in view of **Hidari et al. (USP 5,774,664)**.

Young teaches the claimed invention except for the broadcast data stream being broadcasted over the Internet.

**Hidari et al.** (Hidari) teaches a broadcast data stream (video programs) being transmitted to computers at user sites over any transmission means including broadcast, cable, satellite, or Internet (col. 5, lines 1-3).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Internet as the transmission means, as is taught by Hidari, for the purpose of delivering Young's broadcast data stream to Hidari's user computers at user sites, or as an additional channel for reaching a larger customer base.

### ***Response to Arguments***

13. Applicant's arguments filed 11/17/03 have been fully considered but they are not persuasive.

With respect to claims 16 and 28, applicant argued on the Remarks section (page 7) that Young does not teach the television programs being captured and stored based upon object identifier contained in the broadcast data stream.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the television programs being captured and stored based upon object identifier contained in the broadcast data stream) are not recited in the rejected claim(s). The limitation "capturing and storing the at least one desired data object from the broadcast data stream in accordance with the fetched schedule and based upon the at least one desired data object's object identifier" does not require the object identifier contained in the broadcast data stream to be used for capturing and storing the desired object. The limitation, therefore, does not preclude the user selecting the desired data object based upon the desired data object's object identifier (program title) from the fetched schedule,

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and therefore capturing and storing the desired data object from the received broadcast data stream in accordance with a fetched schedule and based upon the desired data object's object identifier. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, it appears that there is no support in applicant's disclosure for the amendment to the claims.

### ***Conclusion***

14. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh Quang Nguyen whose telephone number is (571) 272-4154 and whose e-mail address is [tanh.nguyen36@uspto.gov](mailto:tanh.nguyen36@uspto.gov). The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached on (571) 272-2100. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for After Final, Official, and Customer Services, or (571) 273-4154 for Draft to the Examiner (please label "PROPOSED" or "DRAFT").

Effective May 1, 2003 are new mailing address is:

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KIM HUYNH  
PRIMARY EXAMINER  
10/29/04

TQN  
October 28, 2004